

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
10/816,712	04/02/2004	Piper et al.	FULLN014USPT02

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

EXAMINER

Andrew W. Sutton

ART UNIT

3765

## APPEAL BRIEF

Dear Sir:

This Appeal Brief is filed on appeal from the decision of the Examiner dated May 12, 2010, rejecting claims 1-18 and 20 in the above-referenced patent application.

**REAL PARTY IN INTEREST**

The real party in interest in connection with this appeal is Full90 Sports, Inc. as assignee of the entire right, title and interest in the application from the inventors Dennis Piper, John Lampe and William Cleveland. The assignment is recorded at reel/frame 014681/0001.

**RELATED APPEALS AND INTERFERENCES**

Appellant and appellant's legal representative are unaware of any other appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

### STATUS OF CLAIMS

The application was filed on April 2, 2004 with claims 1-20. Claims 1-6, 8, 13, 14, 17, 18 and 20 were amended, and claim 19 canceled in an Amendment and Response originally filed on January 30, 2006 and refiled on February 6, 2006 in response to a Notice of Non-Compliant Amendment. Claims 1, 9 and 20 were amended in an Amendment and Response filed on January 21, 2010. Claims 1-18 and 20 remain pending in the application. Claims 1-18 and 20 have been finally rejected. No claims have been allowed.

The rejection of claims 1-18 and 20 is appealed. A copy of the claims involved in this appeal is provided in the Appendix section of this Appeal Brief.

**STATUS OF AMENDMENTS**

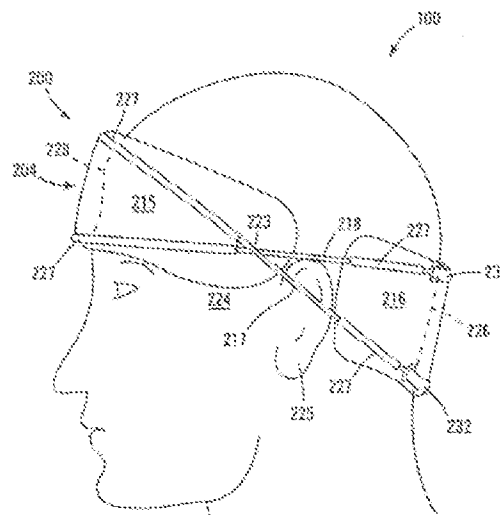
No amendment has been filed subsequent to final rejection of the appealed claims.

### SUMMARY OF CLAIMED SUBJECT MATTER

The application contains four independent claims (claims 1, 9, 14 and 20).

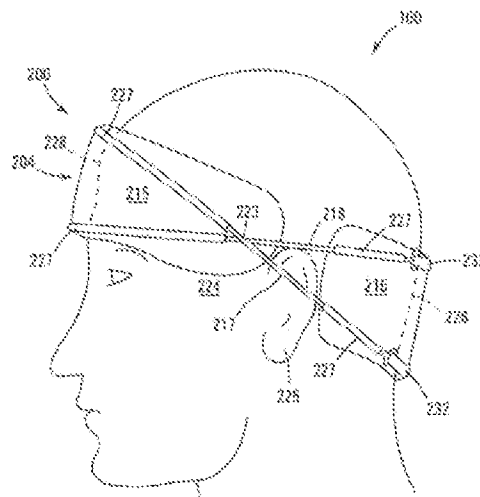
## CLAIM 1

A First Embodiment of the Present Claimed Invention (claims 1-8) is a protective headguard (200) to be worn on a human head (100). The headguard (200) includes a protective pad (215) and a retention element (217) and (218) cooperatively attached to the protective pad (215), with the retention element (217) and (218) embodying at least two separate and distinct circumferential lines of retention (111) and (112) that both extend laterally across the forehead [(104) in Figure 1d and (204) in Figure 2a] and intersect at diametric points of intersection [(102) in Figure 1d and (223) in Figure 2a] when the headguard (200) is worn on the head (100). [Page 12, Line 29 through Page 15, Line 6 and Figures 1d and 2a].



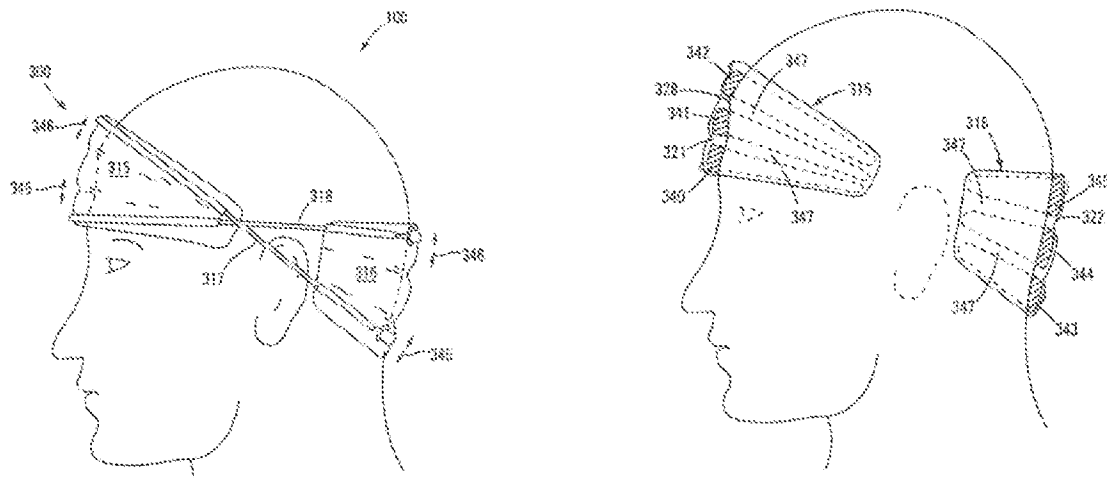
CLAIM 9

A Second Embodiment of the Present Claimed Invention (claims 9-13) is a protective headguard (200) to be worn on a human head (100). The headguard (200) includes a protective pad (215) and a pair of separate and distinct retention elements (217) and (218) attached to the protective pad (215) that both extend laterally across the forehead (204) and intersect at diametric points of intersection (223) when the headguard (200) is worn on the head (100). [Page 12, Line 29 through Page 15, Line 6 and Figure 2a].



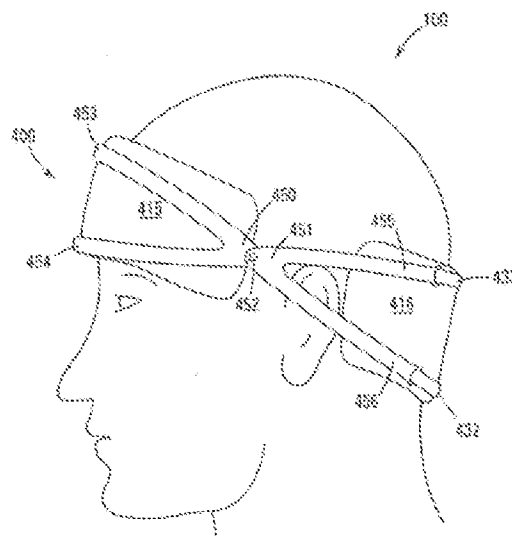
CLAIM 14

A Third Embodiment of the Present Claimed Invention (claims 14-18) includes a front protective piece (315) and a rear protective piece (316) with a plurality of pads (343), (344) and (345) on the rear protective piece (316) that are capable of shifting relative to one another. [Page 16, Lines 9-30 and Figures 3a and 3b].



## CLAIM 20

A Fourth Embodiment of the Present Claimed Invention (claim 20) includes a padded front piece (415) and a padded rear piece (416) pivotally attached to one another at diametrically opposed pivot points (452) whereby the pieces (415) and (416) may be independently pivoted about the pivot points (452). The front and rear pieces (415) and (416) are constructed to protect a wearer against physical injury from a blow to the head (100). [Page 17, Lines 1 -18 and Figure 4].





**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. The rejection of claim 20 under 35 U.S.C. §102(a) as anticipated by Lampe (820) (United States Patent No. 6,625,820).

2. The rejection of claims 1-13 under 35 U.S.C. §103(a) as obvious over Lampe (820) (United States Patent No. 6,625,820) in view of Wallman (United States Patent No. 1,638,756).

3. The rejection of claims 14-16 and 18 under 35 U.S.C. §103(a) as obvious over Steffen (United States Patent No. 3,171,133) in view of Lampe et al. (399) (United States Patent No. 6,397,399).

4. The rejection of claim 17 under 35 U.S.C. §103(a) as obvious over Steffen (United States Patent No. 3,171,133) in view of Lampe et al. (399) (United States Patent No. 6,397,399) and further in view of Mattes (054) (United States Patent No. 4,741,054).

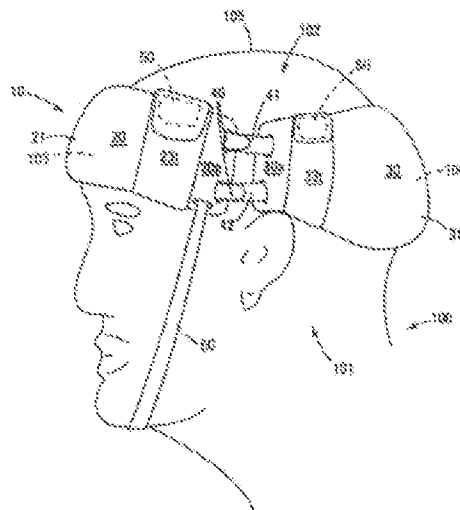
## ARGUMENT

### *Objections/Rejections Under 35 U.S.C. § 102*

*1.0 The Examiner has rejected claim 20 under 35 U.S.C. §102(a) as anticipated by Lampe (820) (United States Patent No. 6,625,820).*

### SUMMARY OF CITED REFERENCE

**Lampe (820)** (United States Patent No. 6,625,820) discloses a protective headguard (10) comprising a front panel (20) and a rear panel (30) connected on each side by upper and lower adjustable straps (40).



*Fig. 10*

### SUMMARY OF CLAIMED INVENTION

The Fourth Embodiment of the Present Claimed Invention (claim 20) includes a front piece and a rear piece pivotally attached to one another at diametrically opposed pivot points whereby the pieces may be independently pivoted about the pivot points.

## LEGAL BASIS

An anticipation rejection under 35 U.S.C. § 102 requires that the cited reference(s) disclose each and every element of the claimed invention. *See, Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Kloster Speedsteel AB et al. v. Crucible Inc. et al.*, 230 U.S.P.Q. 81, 84 (Fed.Cir. 1986). A reference anticipates a claim only when the reference discloses each and every element recited in the claim. *See, Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) and M.P.E.P. §2131. Accordingly, the “exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” *Atlas Powder Co. v. E.I. duPont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

## ARGUMENT

### *Lampe (820) Does Not Disclose Each and Every Element of the Claimed Invention*

The Fourth Embodiment of the Present Claimed Invention has front and rear pieces *pivotally* attached to one another at diametrically opposed *pivot points* whereby the pieces may be independently *pivoted about the pivot points*. The front and rear pieces disclosed in Lampe (820) are not attached to one another at a pivot point. Rather, the front and rear pieces are connected by upper and lower adjustment straps that would prohibit pivoting of the pieces relative to one another when constructed of a rigid material, and permit free-form movement of the pieces relative to one another when constructed of a pliable material.

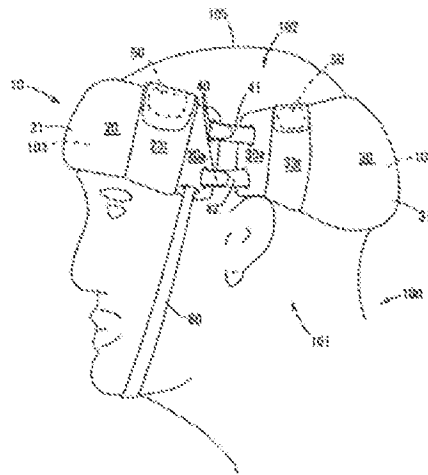
Withdrawal of this rejection is respectfully requested.

***Objections/Rejections  
Under 35 U.S.C. § 103***

**2.0** The Examiner has rejected claims 1-13 under 35 U.S.C. §103(a) as obvious over Lampe (820) (United States Patent No. 6,625,820) in view of Wallman (United States Patent No. 1,638,756).

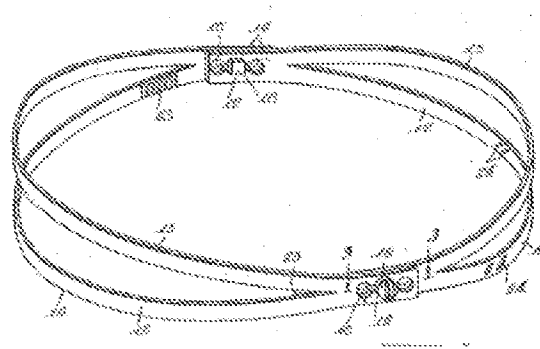
**SUMMARY OF CITED REFERENCES**

**Lampe (820)** (United States Patent No. 6,625,820) discloses a protective headguard (10) comprising a front panel (20) and a rear panel (30) connected on each side by upper and lower adjustable straps (40).



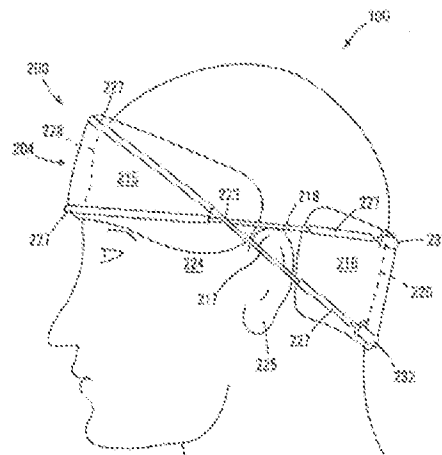
*Fig. 10*

**Wallman** (United States Patent No. 1,638,756) discloses an ornamental head dress having a front section (10) and a back section (11), each having an upper band (13) and a lower band (12). The front (10) and back (11) sections are adjustably connected at diametrically opposed points of attachment (18) for fitting of the head dress.



#### SUMMARY OF CLAIMED INVENTION

Both the First Embodiment of the Present Claimed Invention (claims 1-8) and the Second Embodiment of the Present Claimed Invention (claims 9-13) are both directed to protective headguards with a retention element embodying at least two separate and distinct circumferential lines of retention that extend laterally across the forehead and intersect at diametric points of intersection.



## LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. The disclosure of all elements, teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

The second criterion is relevant to this rejection.

## ARGUMENT

### Motivation

In order to determine the propriety of an obviousness rejection, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution, combination, or other modification. In re Linter, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. §2143.01.

*Cited References Lack Motivation to Combine the References  
To Achieve the Present Claimed Invention  
and Actually Teach Away From Such a Combination*

Lampe (820) discloses a protective headguard with front and rear panels connected by upper and lower adjustable straps that define separate and distinct *nonintersecting* circumferential lines

of retention that extend laterally across the forehead. Wallman discloses an ornamental head dress having a front section and a back section, with each section having an upper band and a lower band. The front and back sections of the Wallman fashion head dress are connected at diametrically opposed points of attachment. Assuming for the sake of argument that the head dress of Wallman forms intersecting circumferential lines of retention when the front and rear sections are attached, the rejection of claims 1-13 as obvious over Lampe (820) in view of Wallman still cannot stand as there is simply no teaching, suggestion or motivation provided in Lampe (820), Wallman or elsewhere, to replace the adjustable straps of Lampe (820) with the head dress of Wallman. Indeed, Lampe (820) actually teaches away from such a substitution as Lampe (820) indicates that comfort, fit, retention and protection are improved by providing one strap that encircles the head above the occipital and frontal bones, and another that encircles the head below the occipital and frontal bones. See, column 6, lines 50-64. Replacing the functional adjustable straps of Lampe (820) with the fashion accessory disclosed in Wallman would eliminate this benefit. See, M.P.E.P. § 2141.03 VI [PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS].

The Examiner's suggested motive of "... reduc[ing] the footprint of the headgear on the wearer" finds no support in the prior art and actually provides a motive to refrain from such a combination as a diminished footprint would result in diminished protection (*i.e.*, reducing the area covered by the headguard would reduce the area protected against an impact).

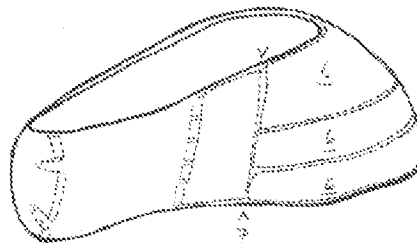
*3.0 The Examiner has rejected claims 14-16 and 18 under 35 U.S.C. §103(a) as obvious over Steffen (United States Patent No. 3,171,133) in view of Lampe et al. (399) (United States Patent No. 6,397,399).*

#### SUMMARY OF CITED REFERENCE

**Steffen** (United States Patent No. 3,171,133) discloses a protective helmet (10) having a one-piece frontal pad (12) and a one-piece posterior pad (18) interconnected by left and right upper elastic straps (22 and 26) and left and right lower elastic straps (24 and 28).



**Lampe et al. (399)** (United States Patent No. 6,397,399) discloses a protective headguard comprising a headband with a multi-piece frontal pad and a single-piece posterior pad retained within pockets in the headband.



#### SUMMARY OF CLAIMED INVENTION

The Third Embodiment of the Present Claimed Invention (claims 14-18) includes a front protective piece and a rear protective piece, each including a plurality of pads capable of shifting relative to one another.

#### LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. The



disclosure of all elements, teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

The first and second criteria are relevant to this rejection.

#### ARGUMENT

##### All Elements

In a fashion similar to the criteria for establishing anticipation, the first element for establishing a prima facie case of obviousness requires that the cited references disclose each and every element of the claimed invention. The distinction between application of this criterion in establishing anticipation and establishing obviousness is that the claimed elements must be found in a single reference to support an anticipation rejection while the claimed elements can be found in multiple references to support an obviousness rejection.

##### *Steffen and Lampe et al. (399) Do Not Disclose Each and Every Element of the Claimed Invention*

The Third Embodiment of the Present Claimed Invention includes a rear protective piece with a plurality of pads capable of shifting relative to one another. The protective headguards of Steffen and Lampe et al. (399) both have a one-piece posterior pad.

##### Motivation

In order to determine the propriety of an obviousness rejection, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution, combination, or other modification. In re Linter, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and

produce the claimed invention. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. §2143.01.

*Steffen and Lampe et al. (399)*

*Provide No Motivation to Rearrange the Headgear of Lampe et al. (399)*

*To Achieve the Present Claimed Invention*

Lampe (399) discloses a protective headguard with only the frontal pad formed as a multi-piece pad. The posterior pad is always referenced and depicted as a single piece. Lampe (399) provides no motive, reasoning or rationale to form both the frontal and posterior padding as multi-piece pads. The Examiner's contention, that the location of the padding as between the front of the head (forehead) and the back of the head (occipital bone) can be ignored for purposes of this rejection, is disingenuous. The headgear disclosed in Lampe (399) is designed to be worn tightly against and conform to the shape of the head. The size and shape of the forehead is vastly different from the size and shape of the occipital bone area at the back of the head. Furthermore, the back of the head is typically covered with hair – often long hair - while the forehead is not. Hence, padding configured, arranged, designed and tailored to comfortably and protectively cover one of these areas are seldom if ever suited for covering the other. Those of routine skill in this art do not routinely incorporate form, fit and function features from frontal padding into posterior padding and vice versa.

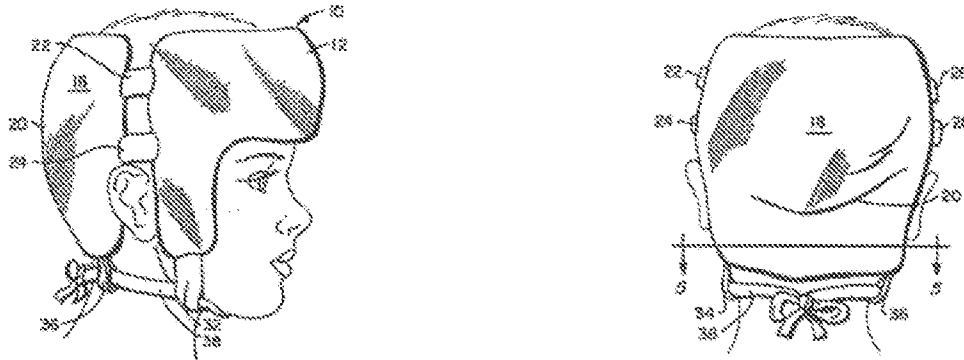
Steffen is silent as to this facet of headgear and therefore contributes nothing of value on this point.

Withdrawal of this rejection is respectfully requested.

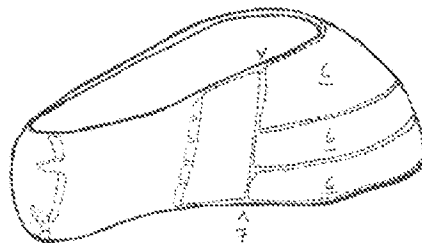
*4.0 The Examiner has rejected claim 17 under 35 U.S.C. §103(a) as obvious over Steffen (United States Patent No. 3,171,133) in view of Lampe et al. (399) (United States Patent No. 6,397,399) and further in view of Mattes (054) (United States Patent No. 4,741,054).*

SUMMARY OF CITED REFERENCE

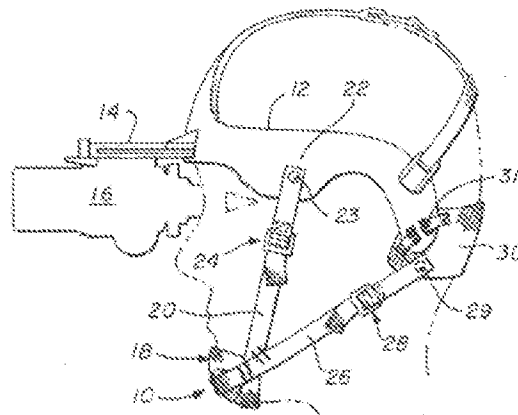
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**Lampe et al. (399)** (United States Patent No. 6,397,399) discloses a protective headguard comprising a headband with a multi-piece frontal pad and a single-piece posterior pad retained within pockets in the headband.



**Mattes (054)** (United States Patent No. 4,741,054) discloses a chin cup (18) for use with military headgear (12). Mattes (054) attaches the chin cup (18) to the headgear (12) with a pair of overlapping chin straps (20 and 26). The headgear (12) depicted by Mattes (054) is a single continuous piece.



#### SUMMARY OF CLAIMED INVENTION

The Third Embodiment of the Present Claimed Invention (claims 14-18) includes a front protective piece and a rear protective piece, each including a plurality of pads capable of shifting relative to one another.

#### LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. The disclosure of all elements, teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

The first and second criteria are relevant to this rejection.

#### ARGUMENT

##### All Elements

In a fashion similar to the criteria for establishing anticipation, the first element for establishing a prima facie case of obviousness requires that the cited references disclose each and every element of the claimed invention. The distinction between application of this criterion in establishing anticipation and establishing obviousness is that the claimed elements must be found in a single reference to support an anticipation rejection while the claimed elements can be found in multiple references to support an obviousness rejection.

##### *Steffen, Lampe et al. (399) and Mattes (054)* *Do Not Disclose Each and Every Element of the Claimed Invention*

The Third Embodiment of the Present Claimed Invention includes a rear protective piece with a plurality of pads capable of shifting relative to one another. The protective headguards of Steffen, Lampe et al. and Mattes (054) each have a one-piece posterior pad.

##### Motivation

In order to determine the propriety of an obviousness rejection, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution, combination, or other modification. In re Linter, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. §2143.01.

*Steffen, Lampe et al. (399) and Mattes (054)*  
*Provide No Motivation to Rearrange the Headgear of Lampe et al. (399)*  
*To Achieve the Present Claimed Invention*

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Steffen and Mattes (054) are silent as to this facet of headgear and therefore contribute nothing of value on this point.

Withdrawal of this rejection is respectfully requested.

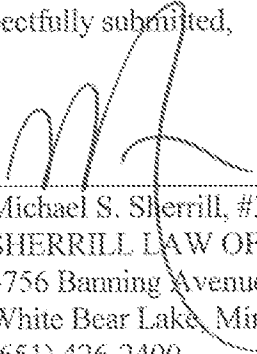
## CONCLUSION

Applicant respectfully submits that all pending claims (claims 1-18 and 20) are in condition for allowance.

Respectfully submitted,

Date 08 Nov 2010

By

  
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## CLAIMS APPENDIX

### PENDING CLAIMS

*United States Patent Application  
Serial No. 10/816,712*

1. A protective headguard to be worn on a human head having a forehead, comprising a protective pad and a retention element cooperatively attached to the protective pad wherein the retention element embodies at least two separate and distinct tensioned and diametrically intersecting circumferential lines of retention that both extend laterally across the forehead when worn on the head.
2. The protective headguard of claim 1 wherein at least a segment of each circumferential line of retention is elastic.
3. The protective headguard of claim 2 wherein at least a segment of each circumferential line of retention is an elastic strap.
4. The protective headguard of claim 3 wherein the headguard further includes a length adjustment means cooperatively attached to each strap for permitting an adjustment of the length of each strap.
5. The protective headguard of claim 1 wherein the lines of retention intersect at intersection points and the intersection points are positioned proximate each temple of a wearer when the protective headguard is worn on the head.
6. The protective headguard of claim 1 wherein the headguard is configured and arranged so that one circumferential line of retention runs above an occipital bone of a wearer and another circumferential line of retention runs below the occipital bone of a wearer.



7. The protective headguard of claim 1 wherein the angle at which the circumferential lines of retention intersect when the headguard is worn is adjustable.
8. The protective headguard of claim 1 wherein the lines of retention intersect at intersection points and the intersection points may be circumferentially shifted.
9. A protective headguard to be worn on a human head having a forehead, comprising a protective pad covering at least a portion of the forehead and a pair of separate and distinct, tensioned and diametrically intersecting retention elements attached to the protective pad that both extend laterally across the forehead when the headguard is worn on the head.
10. The protective headguard of claim 9 wherein at least a segment of each retention element is elastic.
11. The protective headguard of claim 9 wherein the retention elements are elastic.
12. The protective headguard of claim 9 wherein the retention elements have a length and include a length adjustment means cooperatively attached to each retention element for permitting an adjustment in the tension of each retention element when the protective headguard is worn on the head.
13. The protective headguard of claim 9 wherein the protective pad and retention element are configured and arranged such that the diametric points of intersection of the retention elements are positioned proximate each temple of a wearer when the protective headguard is worn on the head.
14. A protective headguard to be worn on a human head, comprising:
  - (a) a rear protective piece including a plurality of pads capable of shifting relative to one another,
  - (b) a front protective piece,

- (c) and a retention element interconnecting the front protective piece and the rear protective piece.
- 15. The protective headguard of claim 14 wherein the retention element is elastic.
- 16. The protective headguard of claim 15 wherein the retention element defines a strap.
- 17. The protective headguard of claim 14 wherein the retention element includes at least one strap and a length adjustment means cooperatively attached to the strap for permitting an adjustment of the length of the strap.
- 18. The protective headguard of claim 14 wherein the front protective piece includes a plurality of pads capable of shifting relative to one another.
- 20. A protective headguard to be worn on a human head, comprising a front piece and a rear piece wherein the front piece and the rear piece are constructed with padding to protect a wearer against physical injury from a blow to the head and pivotally attached to one another at diametrically opposed pivot points whereby the front piece and the rear piece may be independently pivoted about the pivot points.

## EVIDENCE APPENDIX

NONE

## RELATED PROCEEDINGS APPENDIX

NONE